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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,604	11/07/2001	Douglas W. Carr	O.N. 63469	4198
22110	7590	10/07/2003	EXAMINER	
SCHROEDER & SIEGFRIED 222 SOUTH NINTH STREET SUITE 2870 MINNEAPOLIS, MN 55402			CHAMBERS, TROY	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/007,604	CARR ET AL.
	Examiner	Art Unit
	Troy Chambers	3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-51 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment filed 6/30/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: subject matter relating to a bullet "devoid of electroplating"; subject matter relating to a "non-bonded" cavity wall.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

1. The following is a quotation of 37 C.F.R. 1.75(a):

The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

2. Claims 2-5, 8-10 and 47-51 are objected to under 37 C.F.R. 1.75, first paragraph as containing insufficient structure to perform the recited functions (e.g. penetrating a target to a particular depth). Applicant's specification requires a bullet characterized by a "series of elements" to allow the bullet to penetrate to the desired depth.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, applicant's independent claims make reference to a "malleable core" having a plurality of "separate segments". However, a review of the specification fails to disclose how these segments are created. Page 9, lines 16-21 broadly discloses wedge-shaped segments 5 "provided" during the forming of the core. On page 10, lines 18-23, applicant jumps to the "final stages" of bullet forming by describing how the segments are pressed together. But, there is no disclosure relating to the means by which the segments are created.

4. Claims 1-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preambles of applicant's independent claims make reference to "current FBI and IWBA standards for law enforcement." However, those standards are not permanent and could change at some point in the future.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-15, 17-25, 28-35, 37, 39-45 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of U.S. 4836110 issued to Burczynski. Moore discloses a bullet 10 comprising a copper jacket 28 with a cylindrical sidewall, a tapered nose 14, and an open end; a lead core 23 having a plurality of segments formed by slits 36. Moore does not disclose a plurality of physically separate core segments intimately compressed together to form a unitary core.

Burczynski discloses such a feature. Specifically, Burczynski discloses a bullet having a core formed by a plurality of parting lines.

At the time of the invention, one of ordinary skill in the art would have found it obvious to provide the bullet of Moore with the initial core-forming features of Burczynski. The suggestion/motivation for doing so would have been to improve the stopping power of the bullet by allowing the bullet to separate into a plurality of individual parts or fragments upon impact with a fluidic target.

7. With respect to claim 6, Moore discloses weakened areas 36 disposed adjacent said segments.

8. With respect to claims 13, 14, 15 and 18, Moore discloses a tapered nose 14 having 6 petals formed by slits on the outer side of the jacket (Fig. 1, top of bullet).

9. With respect to claim 19, Moore discloses a hollow point bullet as described above including a nose portion with adjacent petals extending "a distance of about one-half the length of said nose portion" (Fig. 1, 2d); and swaged boundary lines 36 defining individuality.

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10. With respect to claims 19-22, 24, and 25 each segment formed by slits 36 is disposed opposite to a petal on the other side of the bullet (Fig. 3A).

11. With respect to claims 28-31, Moore discloses a nose 14 having a generally conical shape (Fig. 1) and petals defined by circumferential deep scores (Fig. 1) and wherein each segment are disposed opposite at least one of said petal (Fig. 3A).

12. With respect to claims 32-36, refer to Fig. 6.

13. With respect to claims 37, 40 and 41, refer to Fig. 1.

14. With respect to claim 39, refer to Figs. 2A-2D.

15. With respect to claim 42, Moore discloses a copper jacket (col. 3, ll. 12-15).

16. The subject matter of claims 43-45 have been rejected as described above.

17. Independent claims 47-51 are duplicates of previously rejected claims with the addition of subject matter relating to the performance of the bullet once it hits a target.

As stated earlier, this type of subject matter is directed to the intended results of the alleged invention. If a prior art bullets contain all of the elements of applicant's claimed bullet then they would necessarily provide the same results.

18. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Burczynski. Moore discloses a hollow point bullet as described above. Moore does not disclose expressly the specific angle of the cavity-defining wall as claimed by the applicant. However, Moore discloses that the walls of the cavity can be inclined to a "desired angle" to further promote the "desired mushrooming." Clearly, this disclosure would suggest to one of ordinary skill in the art that the mushrooming of the bullet petals is a function of the angle of the incline of the walls and that both the

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mushrooming effect and the wall angle can be manipulated as desired to obtain the necessary mushroom characteristics. The specific values claimed by the applicant are not novel values - - but values that can easily be selected as an engineering design choice by one skilled in the art of bullet making. Additionally, the specified angles claimed by the applicant are optimum values chosen to cause a specific result. Such values would have been obvious to one having ordinary skill in the art, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

19. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Burczynski and in further view of U.S. Patent No. 6257149 issued to Cesaroni. Moore and Burczynski disclose a hollow point bullet 10 as described above. However, Moore and Burczynski do not disclose expressly, a hollow point bullet having a polymer core. Cesaroni discloses a lead-free bullet having a polymer core. (Col. 4, ll. 39-67). At the time of the invention, one of ordinary skill in the art would have found it obvious to provide the hollow point bullet of Moore and Burczynski with the polymer core of Cesaroni. The suggestion/motivation would have been to avoid the health-adverse effects associated with bullets comprised of lead.

20. Claims 27 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Burczynski and in further view of U.S. Patent No. 5641937 issued to Carter. Moore discloses a hollow point bullet as described above. However, Moore does not disclose a bullet in which the jacket has wall thickness that is variable or, more specifically, increases from a forward end to a rearward end. Carter discloses such a

feature. At the time of the invention, it would have been obvious to one of ordinary skill in the art to provide the hollow point bullet of Moore with the variable wall thickness of Carter. The suggestion/motivation for doing so would have been to reduce the overall expansion of the expanded bullet at high impact velocities (col. 2, ll. 6-10).

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents listed on form PTO-892 are cited as of interest to show similar hollow point bullets.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Chambers whose telephone number is (703) 308-5870. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone, can be reached at (703) 306-4198.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-7687.

DJC  
SUPERVISOR, PATENT EXAMINERS

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